

REMARKS

This is a full and timely response to the final Official Action mailed **October 6** (Paper No. 8). Reconsideration of the application in light of the following remarks is respectfully requested. Claims 1-36 are currently pending for the Examiner's consideration.

With regard to the prior art, the Office Action rejected claims 1-3, 7-13, 16-18, 20-22 and 24 as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,574,495 to Caporizzo. ("Caporizzo"). All other examined claims were rejected under 35 U.S.C. § 103(a) as obvious in view of the teachings of Caporizzo, taken alone or in combination with a variety of other prior art references. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

A method of locating set-top terminals within a cable television system and using location information for said terminals to improve efficient operation of said cable television system, the method comprising:

with a system controller, automatically determining which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal; and

identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal;

wherein a location of said set-top terminal within said system comprises an identification of said upstream plant and said associated downstream plant.

Similar subject matter is recited in independent claims 11 and 20.

In contrast, Caporizzo does not teach or suggest a *system controller* that "automatically determin[es] which upstream plant of a plurality of upstream plants transmits a first message to said system controller from a particular set-top terminal."

According to the final Office Action, “Caporizzo teaches a first message containing 217784 received at the headend. The headend (claimed system controller) automatically determines which upstream plant of a plurality of upstream plants transmits the message by deciphering the message, in this case the 2 is the trunk number, 1 is the line extender, and 7784 is the set top serial number.” (Paper No. 8, p. 2). This is a significant misstatement of what Caporizzo actually teaches.

Caporizzo does not teach or suggest that the identification number 217784 is received at the headend in a first message from a previously unlocated set-top terminal as suggested in the final Office Action. Rather, Caporizzo states that “*the headend 15 includes a database of the entire CATV network topology. As part of the cable system customer database each subscriber is identified by specifying a specific address. For example, a settop terminal 10 located on cable system trunk number 2, line extender 1, with settop Ser. number 7784 will have a terminal identification number of 217784.*” (Col. 6, lines 5-10) (emphasis added). The headend then uses the addresses already in the database to communicate downstream (*i.e.*, to poll) specific set-top terminals. (Col. 6, line 10).

Thus, Caporizzo teaches a database *already at the headend* which includes addresses that specify a *downstream* path for each set-top terminal. These addresses are apparently not created by the headend, but are provided to the headend as set-top terminals are manually added to the system. These addresses specify a downstream path to a set-top terminal and do not represent or designate an upstream plant for each set-top terminal.

Consequently, Caporizzo does not teach or suggest that the headend or “system controller” “automatically determine[es] which upstream plant from a plurality of upstream

plants transmits a first message to said system controller from a particular set-top terminal.” Moreover, Caporizzo does not teach or suggest that, once the upstream plant has been automatically identified, the method proceeds by “identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal.” The downstream plant for each set-top terminal is already recorded in the headend database taught by Caporizzo.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, because Caporizzo fails to teach or suggest any of the features of independent claims 1, 11 and 20, the rejection of claims 1-24 should be reconsidered and withdrawn.

Claim 3 recites the “method of claim 1, further comprising assigning attributes for said set-top terminal based on said location of said set-top terminal. Claims 13 and 22 recites similar subject matter.

In response, the recent Office Action states that “if any changes are made to the set top terminal at the user’s home, they are performed ‘based on said location of the said set top terminal’ in order to permit the user to receive additional services.” (Paper No. 8, p. 3). Applicant respectfully disagrees.

The Office is entitled to give claim language its broadest reasonable interpretation. (MPEP § 2111). However, this interpretation is beyond the broadest *reasonable*

interpretation of the claims. Assigning attributes based on location clearly means that *the specific attributes assigned are selected because of the location of the set-top terminal.* This implies that set-top terminals at different locations will be assigned different attributes, i.e., attributes vary with location. In this regard, the Office Action notes that Caporizzo mentions that subscribers may be authorized to receive particular channels or services (Col. 3, lines 3-5). However, that authorization is "based on" the subscriber signing up for and paying for those services. Caproizzo makes clear that subscribers in any part of the system can pay for and receive these services. Thus, there is no differentiating "based on" location.

Consequently, Caporizzo completely fails to teach or suggest assigning terminal attributes *based on* the terminal's location. Again, "[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Therefore, because Caporizzo fails to teach or suggest any of the features of claims 3, 13 and 22, the rejection of these claims should be reconsidered and withdrawn.

Claim 28 recites:

A method of adding a set-top terminal to a cable television system, said method comprising:
 selling a set-top terminal;
 connecting said set-top terminal to said cable television system without advance notice to operators of said cable television system;
 with a system controller, automatically determining which upstream plant of a plurality of upstream plants transmits a first message to said a system controller from a particular set-top terminal; and
 identifying a downstream plant associated with the upstream plant that transmits said first message from said set-top terminal;
 wherein a location of said set-top terminal within said system comprises an identification of said upstream plant and said associated downstream plant.

In contrast, Caporizzo fails to teach or suggest selling a set-top terminal and “connecting said set-top terminal to said cable television system without advance notice to operators of said cable television system,” where the system then automatically locates the terminal within the system to establish two-way communication with the terminal. The final Office Action has failed to indicate how or where Caporizzo teaches and suggests all the features of claim 28, particularly the sale of the set-top terminal and connecting it to the cable system without prior notice to the system operators.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least this reason, the rejection of claim 28 and its dependent claims should be reconsidered and withdrawn.

Claims 25 and 28-36 were rejected under 35 U.S.C. § 112, first paragraph, as lacking written description in the application as originally filed. Both claims recite a method step of “selling a set-top terminal.” According to the Office Action, the “specification, on page 16, lines 4-17, discloses purchasing and installation of set-top terminals by consumers; but does not convey a method of selling; but merely the user purchasing.” (Paper No. 8, p. 4). Applicant respectfully disagrees.

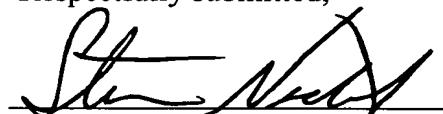
The obvious question is how the specification can describe the user purchasing the set-top terminal, as noted by the Office Action, and not also convey to one of skill in the art that the set-top terminal is being sold.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. There is no requirement that Applicant use precisely the same language in the specification as in the claims, i.e., “there is no *in haec verba* requirement.” MPEP §2163. “Newly added claim limitations [may] be supported in the specification through express, *implicit*, or *inherent* disclosure.” MPEP §2163 (emphasis added).

It seems to strain credibility to suggest that one of skill in the art would read about a consumer purchasing a set-top terminal and not understand that a sale of the set-top terminal is being described by the Applicant. In truth, the Applicant has described the sale of a set-top terminal that is purchased by a consumer and has claimed a method step of “selling a set-top terminal.” Consequently, the written description requirement of §112, first paragraph, has clearly been met. Therefore, reconsideration and withdrawal of the rejection under § 112 is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

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Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)